

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed June 15, 2005. No claims are amended herein, and claims 18-28 and 46-61 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the following remarks.

Allowable Claims

The Examiner objected to claims 27, 28, 48, 49, 56 and 57 but indicated that these claims would be allowable if amended to contain the limitations of their base claims and any intervening claims. Applicants respectfully decline to amend these claims at this time, in view of the arguments presented below for the patentability of the base claims.

Rejections Under 35 U.S.C. § 103

The Examiner rejected all claims in the application under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over, various combinations of the following references: U.S. Patent No. 5,525,788 to Bridgelall *et al* (“Bridgelall”); U.S. Patent No. 6,560,741 to Gerety *et al* (“Gerety”); and U.S. Patent No. 5,515,962 to Kennedy *et al.* (“Kennedy”). The Examiner also relied on either U.S. Patent No. 5,737,438 to Zlotnick *et al.* (“Zlotnick”) or U.S. Patent No. 5,768,023 to Sawaki *et al.* (“Sawaki”). How the Examiner applied Zlotnick and Sawaki is unclear, since the Examiner cited but did not discuss Zlotnick and discussed but did not cite Sawaki. Specifically, the Examiner rejected claims 18, 46, 51-54 and 59-61 as unpatentable over Bridgelall in view of Gerety, rejected claims 19-24 as unpatentable over Bridgelall in view of Gerety and further in view of Kennedy, and rejected claims 25, 26, 47, 50, 55 and 58 as unpatentable over Bridgelall in view of Gerety and further in view of either Sawaki or Zlotnick.

Applicants respectfully traverse the Examiner’s rejections. To establish a *prima facie* case of obviousness, the Examiner must establish that three criteria are met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness.

Claim 18 recites an article of manufacture combination comprising a machine-readable medium that provides instructions, including instructions to process a single received trigger signal communicated from a triggering device in response to a location of a component in an automated identification system, capture multiple images of at least a portion of a surface of the component in response to the received trigger signal, “the multiple images comprising a series of images including a first two-dimensional image and at least one subsequent two-dimensional image,” store the multiple images in a memory, and “process the multiple images to identify and read a symbol code, if any, contained within at least one or a combination of two or more of the multiple images.”

The Examiner concedes that Bridgelall fails to teach the symbol being a two-dimensional symbol, capturing multiple images of the symbol with a CMOS image sensor, and processing the multiple images to identify and read the code affixed to the object, wherein the processing included a memory for storing each image so that the images can be combined for decoding and displayed. The Examiner alleges, however, that Gerety discloses these elements, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bridgelall and Gerety to arrive at the claimed invention.

Applicants respectfully disagree. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, there is no suggestion of the desirability of the combination attempted by the Examiner. Bridgelall is fundamentally a laser scanning system in which the one and only purpose of the imaging camera is to determine the position and orientation of a barcode so that the laser scanner can adjust its scanning pattern to read the barcode. The laser scanner then reads and decodes the barcode as known in the art. Bridgelall provides no disclosure, teaching or suggestion that the single image captured with the camera is or should be used for any purpose besides locating the barcode, and the image captured by the camera is never used for decoding the barcode to extract data. In fact, Bridgelall teaches that the only way to obtain data from a barcode is through laser scanning, and its entire disclosure is directed to improving laser scanning. A person skilled in the art would therefore not interpret

Bridgelall's disclosure as including any kind of suggestion to combine with a reference such as Gerety in which a camera is used for reading and decoding barcode.

Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (holding that a combination of references did not obviate a claimed invention because the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate"). As discussed above, Bridgelall relies on laser scanning to read a barcode, while Gerety relies on machine vision. Laser scanning and machine vision are fundamentally different technologies in every respect—the required hardware differs, the data collection differs, the data processing differs, and the decoding differs. Gerety therefore could not be combined with Bridgelall because it would completely change the principle of operation of Bridgelall from laser scanning to machine vision. Moreover, because Bridgelall and Gerety differ so greatly in their principle of operation, combining Gerety with Bridgelall would render useless a substantial amount of the hardware in Bridgelall, because nearly all the hardware and software support and operate the laser scanner. In short, then, Bridgelall would require a substantial redesign and reconstruction before it could be combined with Gerety. For the above reasons, Applicants submit that Bridgelall and Gerety cannot obviate the claim and respectfully request withdrawal of the rejection and allowance of the claim.

As to claims 19-26, Applicants respectfully traverse the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 18 is in condition for allowance. Applicants respectfully submit that claims 19-26 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 46 recites a method combination including “receiving a single trigger signal communicated from a triggering device” in response to a location of a component in an automated identification system, capturing multiple images of at least a portion of a surface of the component in response to the trigger signal, “the multiple images comprising a series of images including a first two-dimensional image and at least one subsequent two-dimensional image, wherein capturing the multiple images comprises capturing at least one of the multiple images via an external camera coupled to the image system,” and “processing the multiple images to identify and read a symbol code, if any, contained within at least one or a combination of two or more of the multiple images.” By analogy to the discussion above for claim 18, Bridgelall and Gerety cannot obviate the claim because neither reference suggests a combination with the other, and because such a combination would change the principle of operation of Bridgelall. Applicants submit that claim 46 is therefore in condition for allowance and respectfully request withdrawal of the rejection and allowance of the claim.

As to claims 47 and 50, Applicants respectfully traverse the Examiner’s rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 46 is in condition for allowance. Applicants respectfully submit that claims 47 and 50 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 51 recites an apparatus combination including an image sensor configured to capture multiple images of at least a portion of a surface of a component in response to a single trigger signal in an automated identification system, “the multiple images comprising a series of images including a first two-dimensional image and at least one subsequent two-dimensional image,” and “a processor, coupled to the memory, to process the multiple images to identify and read a symbol code, if any, contained within at least one or a combination of two or more of the multiple images.” By analogy to the discussion above for claim 18, Bridgelall and Gerety cannot obviate the claim because neither reference suggests a combination with the other, and because such a combination would change the principle of

operation of Bridgelall. Applicants submit that claim 51 is therefore in condition for allowance and respectfully request withdrawal of the rejection and allowance of the claim.

As to claims 52-53, Applicants respectfully traverse the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 51 is in condition for allowance. Applicants respectfully submit that claims 52-53 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 54 recites a method combination including "receiving a single trigger signal communicated from a triggering device" in response to a location of a component in an automated identification system, capturing multiple two-dimensional images of at least a portion of a surface of the component in response to the trigger signal, "the multiple two-dimensional images comprising a series of images including a first image and at least one subsequent image, wherein capturing the multiple two-dimensional images comprises capturing at least one of the multiple two-dimensional images via an external camera coupled to the image system," and "processing the multiple two-dimensional images to identify and read a symbol code, if any, contained within at least one or a combination of two or more of the multiple two-dimensional images." By analogy to the discussion above for claim 18, Bridgelall and Gerety cannot obviate the claim because neither reference suggests a combination with the other, and because such a combination would change the principle of operation of Bridgelall. Applicants submit that claim 54 is therefore allowable and respectfully request withdrawal of the rejection and allowance of the claim.

As to claims 55 and 58, Applicants respectfully traverse the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 54 is in condition for allowance. Applicants respectfully submit that claims 55 and 58 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 59 recites an apparatus combination including “an image sensor configured to capture multiple two-dimensional images of at least a portion of a surface of a component in response to a single trigger signal in an automated identification system, the multiple two-dimensional images comprising a series of images including a first image and at least one subsequent image” and “a processor, coupled to the memory, to process the multiple images to identify and read a symbol code, if any, contained within at least one or a combination of two or more of the multiple images.” By analogy to the discussion above for claim 18, Bridgelall and Gerety cannot obviate the claim because neither reference suggests a combination with the other, and because such a combination would change the principle of operation of Bridgelall. Applicants submit that claim 59 is therefore in condition for allowance and respectfully request withdrawal of the rejection and allowance of the claim.

As to claims 60-61, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 59 is in condition for allowance. Applicants respectfully submit that claims 60-61 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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